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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
10/024,328	12/21/2001	Takeyoshi Isogai	111495	6757
25944	7590	10/19/2004	EXAMINER	
OLIFF & BERRIDGE, PLC			TRINH, MINH N	
P.O. BOX 19928			ART UNIT	
ALEXANDRIA, VA 22320			PAPER NUMBER	
			3729	

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/024,328	Applicant(s) ISOGAI ET AL.	
	Examiner Minh Trinh	Art Unit 3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
 4a) Of the above claim(s) 3,7-11 and 13-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/21/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicants' elected species 1A (claims 1, 2, 4-6 and 12) filed on 7/16/04 with traverse is noted, asserting that there is no serious burden on the examiner to examine all claims. The traverse has been carefully considered, but is not persuasive because the reasons proffered do not appear germane to the propriety of a requirement for election of species. The sections of the manual cited relate to restriction, not a requirement for election of species, which is clearly covered in section 808.01(a). Once the claims are determined to be directed to mutually patentable inventions and the Office requires an election of species, a persuasive traverse is an admission on the record that applicant does not find the claimed species are patentable, one over the other. Having not done so, the reasons presented are not persuasive. Applicant is not entitled to examination of multiple independent inventions in one application. Moreover, examination of the independent inventions herein would clearly present a burden because the searches will not be coextensive. Accordingly, the requirement is repeated and **made final**. Thus, non-elected inventions of Species IB and 1C (claims 3, 7-11 and 13-16) are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 7/16/04.

An Office action on the merits of claims 1, 2, 4-6 and 12 as follows.

2. The information disclosure statement filed 12/21/2001 (i.e., item 1 and 2) fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign

patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. It is noted that a list of US patent and/or publication related to items 1 and 2 is required.

Claim Objections

3. "An apparatus" (claims 2, 4-6 and 12, line 1) should be changed to: --the electric component holding apparatus-- as so to reflect the dependent claim formats. Appropriate correction is required.

Specification

4. The abstract of the disclosure should be within range of 50-150 words in form of a single paragraph. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 2, 4-6 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following are examples:

It is not clear what is being referring as " in a direction to cause the component holder to move away from the holder holding member" (claim 1, line 19-20), and "a direction to increase an amount of elastic deformation (claim 1, line 22), etc.

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The limitation recites" . . . a ball which as a diameter greater than a length of the though hole" (claim 5, line 2-3) is incorrect, it appears that a ball having a diameter greater than a diameter of the through hole.

"the fitting hole" (claim 12, line 2) should have been changed to: -- the inner fitting hole--.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1 and 2 as best understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Furuya et al (6,161,886).

Furuya et al disclose a component holding apparatus comprising:
a component holder 22 which holds an electric component and which includes an engaging portion (see Figs. 1-2); a holder-holding member 22b to which the component holder is detachably attached; a lock member which consists of a substantially rigid body (see Figs. 1-2), and which is supported by the holder-holding member such that

the lock member is movable relative to the holder-holding member, and is engaged with the engaging portion of the component holder to lock the component holder to the holder-holding member (see Fig. 2); and a locked-state maintaining device 27 which includes an operable member 26 and an elastic member 25 and which maintains, owing to an elastic force of the elastic member, a locked state in which the lock member is engaged with the engaging portion of the component holder, wherein the locked-state maintaining device does not allow, when a force is exerted to the component holder in a direction to cause the component holder to move away from the holder-holding member, the force to be exerted to the lock member in a direction to increase an amount of elastic deformation of the elastic member 25, and allows, when an operating force is applied to the operable member in the direction to increase the amount of elastic deformation of the elastic member, the lock member to be disengaged from the engaging portion of the component holder and unlocked from the locked state (see Fig. 2, and the discussion at col. 7, lines 28-36). Since, Furuya et al meet every aspect structure limitations of claim 1 therefore it is capable of fulfilling the functions such as for owing to an elastic force of the elastic member, maintaining device does not allow, when a force is exerted to the component holder in a direction to cause the component holder to move away from the holder-holding member, etc as recite in the claims (see claim 1, lines 17-27).

Note that references 22 and 22b of the reference represented the broadly claimed "holder, and holder holding member" as claimed by the present application.

Limitation of claim 2 is also met by Furuya et al (see Fig. 1, and the discussed at col. 5, lines 50-57).

9. Furthermore, claims 1 and 2 as best understood are also rejected under 35 U.S.C. 103(a) as being unpatentable over Furuya et al (6,161,886).

Furuya et al inherently discloses the claimed holding apparatus of the present application (see Figs. 6-8) of Furuya et al, depicts substantially every structural limitations recited in claims 1-2 i.e., holder member 4 operatively attached to a holder holding member 11, a lock member 9 and an associated latched state maintaining device of 12a, 12b, and 13a, 13b as shown in Fig. 4 of Furuya et al. Regarding the functions associated as recited in claim 1, lines 17-27, since all structural limitations are met by Furuya et al therefore the applied art is capable of fulfilling such functions as described in claim 1, lines 17-27.

Limitation of claim 2 is also met by Furuya et al (see Fig. 4, shows a suction nozzle 11).

Allowable Subject Matter

10. Claims 4-6 and 12 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.


Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art references cited for their teaching of component mounting apparatus or the like.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (703) 305-2887. The examiner can normally be reached on Monday -Thursday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Minh Trinh 10/18/04
Primary Examiner Group 3729

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